



3510-16-P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Madrid Protocol

ACTION: Proposed collection; comment request.

SUMMARY: The United States Patent and Trademark Office (USPTO), as part of its continuing effort to reduce paperwork and respondent burden, invites the general public and other Federal agencies to comment on the extension of a continuing information collection, as required by the Paperwork Reduction Act of 1995, Public Law 104–13 (44 U.S.C. 3506(c)(2)(A)).

DATES: Written comments must be submitted on or before *{insert date 60 days after the date of publication in the Federal Register, in the format “month, day, year”}*.

ADDRESSES: Written comments may be submitted by any of the following methods:

- *Email:* InformationCollection@uspto.gov. Include “0651–0051 comment” in the subject line of the message.

- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Marcie Lovett, Records Management Division Director, Office of the Chief Information Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Catherine Cain, Attorney Advisor, Office of the Commissioner for Trademarks, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450; by telephone at 571–272–8946; or by email at Catherine.Cain@uspto.gov with “0651-0051 comment” in the subject line. Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

This collection of information is required by the Trademark Act of 1946, 15 U.S.C. § 1051 *et seq.*, which provides for the Federal registration of trademarks, service marks, collective trademarks and service marks, collective membership marks, and certification marks. Individuals and businesses that use or intend to use such marks in commerce may file an application to register the marks with the United States Patent and Trademark Office (USPTO).

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“Madrid Protocol”) is an international treaty that allows a trademark owner to seek registration in any of the participating countries by filing a

single international application. The International Bureau (IB) of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, administers the international registration system. The Madrid Protocol Implementation Act of 2002 amended the Trademark Act to provide that: (1) the owner of a U.S. application or registration may seek protection of its mark in any of the participating countries by submitting a single international application to the IB through the USPTO and (2) the holder of an international registration may request an extension of protection of the international registration to the United States. The Madrid Protocol became effective in the United States on November 2, 2003, and is implemented under 15 U.S.C. § 1141 *et seq.* and 37 CFR Part 2 and Part 7.

An international application submitted through the USPTO must be based on an active U.S. application or registration and must be filed by the owner of the application or registration. The USPTO reviews the international application to certify that it corresponds to the data contained in the existing U.S. application or registration before forwarding the international application to the IB. The IB then reviews the international application to determine whether the Madrid filing requirements have been met and the required fees have been paid. If the international application is unacceptable, the IB will send a notice of irregularity to the USPTO and the applicant. The applicant must respond to the irregularities to avoid abandonment, unless a response from the USPTO is required. After any irregularities are corrected and the application is accepted, the IB registers the mark, publishes the registration in the WIPO Gazette of International Marks, and sends a certificate to the holder.

When the mark is registered, the IB notifies each country designated in the application of the request for extension of protection. Each designated country then examines the request under its own laws. Once an international registration has been issued, the holder may also file subsequent designations to request an extension of protection to additional countries.

Under Section 71 of the Trademark Act, 15 U.S.C. § 1141(k), a registered extension of protection to the United States will be cancelled unless the holder of the international registration periodically files affidavits of continued use in commerce or excusable nonuse. The first affidavit must be filed on or between the fifth- and sixth-year anniversaries of the date on which the USPTO registers an extension of protection.

This collection includes the information necessary for the USPTO to process applications for international registration and related requests under the Madrid Protocol. The USPTO provides electronic forms for filing the items in this information collection online (except for the Request to Record an Assignment or Restriction of a Holder's Right to Dispose of an International Registration) using the Trademark Electronic Application System (TEAS), which is available through the USPTO Web site.

Applicants may also submit the items in this collection on paper or by using the forms provided by the IB, which are available on the WIPO Web site. The IB requires Applications for International Registration and Applications for Subsequent Designation that are filed on paper to be submitted on the official IB forms.

II. Method of Collection

Electronically if applicants submit the information using the TEAS forms. By mail or hand delivery if applicants choose to submit the information in paper form.

III. Data

OMB Number: 0651–0051.

IC Instruments: The individual instruments in this collection, as well as their associated forms, are listed in the table below.

Type of Review: Revision of a Previously Existing Information Collection

Affected Public: Individuals or households; businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: 16,557 responses per year. Of this total, the USPTO expects that 16,474 responses will be submitted electronically via the TEAS system and 83 will be submitted on paper.

Estimated Time per Response: The USPTO estimates that it will take the public approximately 17 minutes to one hour and 15 minutes (0.28 to 1.25 hours) to complete the information in this collection, including the time to gather the necessary information, prepare the forms or documents, and submit the completed request to the USPTO.

Estimated Total Annual Respondent Burden Hours: 4,918.45 hours.

Estimated Total Annual Respondent (Hourly) Cost Burden: \$1,913,277.05. The USPTO expects that an attorney will complete the instruments associated with this information collection. The professional hourly rate for an attorney is \$389. When this hourly rate is applied to the 4,918.45 burden hours projected annually for this collection, the USPTO estimates \$1,913,277.05 per year for the total hourly costs associated with respondents.

The time per response, estimated annual responses, and estimated annual hour burden associated with each instrument in this information collection is shown in the table below.

IC Number	Information Collection Instrument	Estimated time for response (minutes) (a)	Estimated Annual Responses (b)	Estimated annual burden hours (a) x (b) / 60 = (c)	Rate (\$/hr)
1	Application for International Registration (PTO-2131 TEAS)	17	8,010	2,269.50	\$389
1	Application for International Registration (paper, no form)	32	33	17.60	\$389
2	Application for Subsequent Designation (PTO-2132 TEAS)	17	1,236	350.20	\$389
2	Application for Subsequent Designation (paper, no form)	22	2	0.73	\$389
3	Response to Notice of Irregularity (PTO-2133 TEAS)	18	1,390	417.00	\$389
3	Response to Notice of Irregularity (paper, no form)	33	1	0.55	\$389
4	Replacement Request (TEAS Global Form)	30	20	10.00	\$389
4	Replacement Request (paper, no form)	45	1	0.75	\$389
5	Request to Record an Assignment or Restriction of a Holder's Right to Dispose of an International Registration (paper, no form)	30	5	2.50	\$389
6	Transformation Request (TEAS Global form)	18	3	0.90	\$389
6	Transformation Request (paper, no form)	33	1	0.55	\$389
6	Transformation Request (TEAS RF Global form)	20	30	10.00	\$389
7	Petition to Director to Review Denial of Certification of International Application (TEAS Global form)	60	100	100.00	\$389
7	Petition to Director to Review Denial of Certification of International Application (paper, no form)	75	20	25.00	\$389
8	Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (PTO-1663 TEAS)	18	3,411	1023.30	\$389
8	Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (paper, no form)	23	10	3.83	\$389

IC Number	Information Collection Instrument	Estimated time for response (minutes) (a)	Estimated Annual Responses (b)	Estimated annual burden hours (a) x (b) / 60 = (c)	Rate (\$/hr)
9	Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (PTO-1683 TEAS)	18	2,274	682.20	\$389
9	Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (paper, no form)	23	10	3.83	\$389
	Total	16,557	4,918.45

Estimated Total Annual (Non-hour) Respondent Cost Burden: \$2,175,480.36. This collection has annual (non-hour) costs in the form of postage costs and filing fees.

Postage Costs

Customers may incur postage costs when submitting some of the items covered by this collection to the USPTO by mail. The USPTO expects that approximately 99 percent of the responses in this collection will be submitted electronically. Of the remaining 1 percent, the vast majority—98 percent—will be submitted by mail, for a total of 82 mailed submissions. The average first-class USPS postage cost for a mailed submission will be 98 cents. Therefore, the USPTO estimates that the postage costs for the mailed submissions in this collection will total \$80.36.

Filing Fees

The USPTO charges fees for processing international applications and related requests under the Madrid Protocol as set forth in 37 CFR 2.6 and 37 CFR 7.6. Most of these fees are charged per class of goods or services; therefore, the total fees can vary depending on the number of classes. Based on the minimum fee of one class per relevant document, the USPTO estimates that the total filing fees in the form of USPTO

processing fees associated with this collection will be approximately \$2,175,400 per year, as calculated in the accompanying table.

IC Number	Item	Estimated annual responses (a)	Fee amount (b)	Estimated annual filing costs (a) x (b) = (c)
1	Application for International Registration (for certifying an international application based on a single basic application or registration, per international class) (PTO-2131 TEAS)	4,110	\$100.00	\$411,000.00
1	Application for International Registration (for certifying an international application based on a single basic application or registration, per international class) (paper, no form)	17	\$100.00	\$1,700.00
1	Application for International Registration (for certifying an international application based on more than one basic application or registration, per international class) (PTO-2131 TEAS)	3,900	\$150.00	\$585,000.00
1	Application for International Registration (for certifying an international application based on more than one basic application or registration, per international class) (paper, no form)	16	\$150.00	\$2,400.00
2	Application for Subsequent Designation (PTO-2132 TEAS)	1,236	\$100.00	\$123,600.00
2	Application for Subsequent Designation (paper, no form)	2	\$100.00	\$200.00
3	Response to Notice of Irregularity (PTO-2133 TEAS)	1,390	\$0.00	\$0.00
3	Response to Notice of Irregularity (paper, no form)	1	\$0.00	\$0.00
4	Replacement Request (per international class) (TEAS Global form)	20	\$100.00	\$2,000.00
4	Replacement Request (per international class) (paper, no form)	1	\$100.00	\$100.00
5	Request to Record an Assignment or Restriction of a Holder's Right to Dispose of an International Registration (paper, no form)	5	\$100.00	\$500.00
6	Transformation Request (per international class) (TEAS Global form)	3	\$325.00	\$975.00
6	Transformation Request (per international class) (paper, no form)	1	\$375.00	\$375.00
6	Transformation Request (per international class) (TEAS RF Global form)	30	\$275.00	\$8,250.00
7	Petition to Director to Review Denial of Certification of International Application (TEAS Global form)	100	\$100.00	\$10,000.00
7	Petition to Director to Review Denial of Certification of International Application (paper, no form)	20	\$100.00	\$2,000.00

IC Number	Item	Estimated annual responses (a)	Fee amount (b)	Estimated annual filing costs (a) x (b) = (c)
8	Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (per international class) (PTO-1553 TEAS)	3,411	\$100.00	\$341,100.00
8	Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (per international class) (paper, no form)	10	\$100.00	\$1,000.00
9	Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (per international class) (PTO-1583 TEAS)	2,274	\$300.00	\$682,200.00
9	Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (per international class) (paper, no form)	10	\$300.00	\$3,000.00
	Total	16,557	\$2,175,400.00

Therefore, the USPTO estimates that the annual (non-hour) cost burden for this collection, in the form of postage costs (\$80.36) and filing fees (\$2,175,400), will total \$2,175,480.36.

IV. Request for Comments

Comments are invited on:

- (a) whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility;
- (b) the accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information, including the validity of the methodology and assumptions used;
- (c) ways to enhance the quality, utility, and clarity of the information to be collected; and
- (d) ways to minimize the burden of the collection of information on respondents,

including through the use of automated collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they will also become a matter of public record.

Dated: August 24, 2015

Marcie Lovett

Records Management Division Director, USPTO

Office of the Chief Information Officer

BILLING CODE 3510-16-P

[FR Doc. 2015-21512 Filed: 8/28/2015 08:45 am; Publication Date: 8/31/2015]